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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,088	01/16/2004	Heidi Riedel	104035.272058	8021

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/760,088	Applicant(s) RIEDEL ET AL.	
	Examiner Gina C. Yu	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/06, 1/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7, 11-17, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Beutler et al. (US 4808388).

Beutler discloses a foamable cosmetic creams for skin, comprising oil-in-water emulsion and propellant. Example 7/2 contains 2 % cetareths-12, 13 % of oil phase comprising mineral oil, 2.5 % stearic acid, and 1 % cetearyl alcohol, and nitrous oxide is used for the pressurized gas. See instant claims 1-3, 12, 15, 16, 21, and 22. The oils in the formulation, isopropyl palmitate, mineral oil, and octyldodecanol are moisturizers, meeting instant claims 11, 13, and 14. Using carbon dioxide is also disclosed. See instant claim 17.

As for claim 13, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See MPEP § 2111.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beutler as applied to claims 1-3, 7, 11-17, 21, and 22 as above, and further in view of Poucher's *Perfumes, Cosmetics and Soaps* (10th ed., 2000).

For the weight ratio of the emulsifiers of instant claims 4-6, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this case, since the reference Beutler provides the general formulations, particularly in col. 4, lines 24 – 30, it would have been obvious to a skilled artisan to discover the optimum weight ratio of the surfactants by routine experimentations. The use of more than one nonionic emulsifier is also obvious because the reference teaches that the nonionic wetting agent can be used by itself or in combination. See col. 2, lines 38 – 42; see also col. 3, line 58 – col. 4, line 4; instant claim 8 and 10.

Beutler does not specifically mention the type of the container for the foaming composition.

Poucher teaches that any aerosol product should be carefully handled, and that aluminum cans are conventionally used for hair mousse compositions, which renders its use for topical foaming composition such as Beutler's cream composition obvious.

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Given the teaching of the creamy foaming composition of Beutler which utilizes pressurized gas components, it would have been obvious to one of ordinary skill in the art at the time of the present invention to look to the prior art such as Poucher for a suitable types of the containers for pressurized compositions. The skilled artisan would have had a reasonable expectation of successfully producing a safe aerosol product for cosmetic use.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beutler as applied to claims 1-3, 7, 11-17, 21, and 22 as above, and further in view of Breuer (US 3923970).

Beutler teaches a comparison formulation which contains sorbitan stearate in the nonionic emulsifier phase in Example 6/1, which is said to be not "sufficiently stable or creamy".

It is well known in cosmetic foaming composition art that sorbitan esters are conventionally used. For example, Breuer teaches a stable aerosol shaving foams, containing mineral oil, sorbitan monostearate, ethoxylate fatty acid esters, and glycerin.

Examiner views that the addition of the sorbitan esters in the Beutler in view of Breuer is obvious for a skilled because 1) Beutler and Breuer teach that this is a conventional nonionic surfactant in formulating a cosmetic foam composition; 2) Breuer teaches that sorbitan monostearate, in combination with mineral oil and ethoxylate fatty acid esters, produce a stable foaming composition. It is also noted that the reference does not suggest that the presence of the sorbitan stearate is the factor which produces a less stable foam, and that there is no weight limitation as to the surfactants in the

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present claims 1 and 8 to conclude that applicants' use of sorbitan esters, with no specific weight limitation, in combination with the Beutler's formulation, is a nonobvious invention. Even if sorbitan monostearate were to produce less viscous foam composition, it is viewed that formulating a variety of foam composition with varying foam density (more liquid than creamy) is within the skill of the art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/760086.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of the claims are directed to a foaming composition and the method of using, with overlapping limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu
Patent Examiner